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10/058,732	01/30/2002	Hirohisa Imai	2002_0110A	5690
53349 7590 02/19/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
NAJARIAN, LENA				
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3686				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/058,732

**Applicant(s)**

IMAI ET AL.

**Examiner**

LENA NAJARIAN

**Art Unit**

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-15, 17-24, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15, 17-24, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 20081119
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the Request for Continued Examination (RCE) filed 1/5/09. Claims 1 and 15 have been amended. Claims 1, 3-15, 17-24, 27, and 28 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, 7-13, 15, 17-19, 21-24, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarkson (US 2003/0046305 A1) in view of Kraftson et al. (6,151,581) in view of Jeacock et al. (6,014,630), and further in view of Tipimneni (US 6,381,029 B1).

(A) Referring to claim 1, Clarkson discloses a communication system for providing information of a medical doctor's questions to patients, said communication system comprising a medical doctor terminal apparatus (abstract, para. 50, and Fig. 2 of Clarkson), a patient terminal apparatus (para. 50 and Fig. 2 of Clarkson), and a database server apparatus for storing question sets for the medical doctor's questions to patients, said medical doctor terminal apparatus, said patient terminal apparatus and said database server apparatus are connected to each other through a communication network (abstract, para. 50, para. 23, para. 27, and Fig. 2 of Clarkson),

wherein said patient terminal apparatus comprises:

first interface means for establishing a network connection and data communication between the database server apparatus and said patient terminal apparatus via the communication network (Fig. 2 of Clarkson);

generating means for generating, upon receiving question sets from said database server apparatus, question programs which are dependent on a particular patient and retaining security of the questions to patients (para. 59, para. 99, and para. 53 of Clarkson);

displaying means for displaying questions for the medical doctor's questions to patients by executing the question programs generated by said generating means (abstract, para. 73, para. 79, and Fig. 1-2, para. 99, para. 102-103, and para. 110 of Clarkson);

entering means for entering answer data to the displayed questions (para. 50, para. 23, para. 27, and Fig. 1-2 of Clarkson); and

transmitting means for transmitting the entered answer data to said database server apparatus, and storing the transmitted answer data in said database server apparatus (abstract, para. 50, para. 23, para. 27, and Fig. 1-2 of Clarkson); and

wherein said medical doctor terminal apparatus comprises second receiving means for receiving the answer data stored in said database server apparatus by accessing said database server apparatus, and displaying the received answer data (abstract, para. 50, para. 23, para. 27 of Clarkson).

Clarkson does not expressly disclose:

first receiving means for receiving at least one question set from said database server apparatus, each question set being dependent on a particular patient among a plurality of patients;

template storing means for storing template question programs which correspond to predetermined answer forms and are not dependent on a particular patient;

presenting question programs which are dependent on a particular patient among a plurality of patients using a patient-independent template program, by inserting

the question sets received from said database server apparatus into the template question programs;

second interface means for terminating the network connection and data communication between the database server apparatus and said patient terminal apparatus; and

wherein the patient dependent question programs are not transmitted through the communication network.

Kraftson discloses first receiving means for receiving at least one question set from said database server apparatus, each question set being dependent on a particular patient among a plurality of patients (col. 6, lines 19-46 of Kraftson).

Jeacock discloses template storing means for storing template question programs which correspond to predetermined answer forms and are not dependent on a particular patient; presenting question programs which are dependent on a particular patient among a plurality of patients using a patient-independent template program, by inserting question sets received from said database into the template question programs, and wherein the patient dependent question programs are not transmitted through a communication network (col. 3, line 59 – col. 4, line 37, col. 1, lines 41-58, col. 2, lines 31-48, and col. 5, line 52 – col. 6, line 4 of Jeacock).

Tipirneni discloses terminating the network connection and data communication (col. 6, lines 28-34 of Tipirneni).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to combine the aforementioned features of Kraftson, Jeacock, and Tipirneni within Clarkson. The motivation for doing so would have been to elicit pertinent information (col. 7, lines 60-67 of Kraftson), to be able to customize the templates as necessary for any unique situations of the patient (col. 1, lines 41-58 of Jeacock), and to ensure confidentiality and security (col. 6, lines 19-46 of Tipirneni).

(B) Referring to claim 3, Clarkson discloses wherein the answer forms include at least one of:

(a) a first answer form for answering by selecting at least one among a plurality of selection sentences of answers as an answer to a question (abstract, para. 13-18, para. 50, and Fig. 1-2 of Clarkson); and

(b) a second answer form for answering by using a numerical value as an answer to the question (abstract, para. 13-18, para. 50, Fig. 1-2 of Clarkson).

(C) Referring to claim 4, Clarkson discloses wherein each of the question sets includes data indicative of an answer form, and a question sentence (abstract, para. 13-18, para. 50, Fig. 1-2 of Clarkson).

(D) Referring to claim 5, Clarkson discloses wherein each of the question sets further includes at least one selection sentence (abstract, para. 13-18, para. 50, Fig. 1-2 of Clarkson).

(E) Referring to claim 7, Clarkson discloses said patient terminal apparatus further

comprises answer data storing means for storing entered past answer data (abstract, para. 50, para. 99, and Fig. 1-2 of Clarkson); and

said displaying means displays past answer data stored in said answer data storing means in conjunction with a question (abstract, para. 99-100, and Fig. 1-2 of Clarkson).

(F) Referring to claim 8, Clarkson discloses wherein the second answer form includes at least one of:

(a) a third answer form for answering by directly entering a numerical value as an answer to the question (abstract, para. 13-18, para. 50, para. 73-78, and Fig. 1-2 of Clarkson); and

(b) a fourth answer form for answering by entering a numerical value indicative of an answer with either one of increasing and decreasing a numerical value starting at an initial value, as an answer to the question (abstract, para. 13-18, para. 50, para. 73-78, and Fig. 1-2 of Clarkson).

(G) Referring to claim 9, Clarkson discloses said patient terminal apparatus further comprises answer data storing means for storing entered past answer data (abstract, para. 50, para. 99 and Fig. 1-2 of Clarkson); and

the initial value of the numerical value is a numerical value indicative of a previous answer of the particular patient included in the past answer data stored in said answer data storing means (abstract, para. 99-100, and Fig. 1-2 of Clarkson).

(H) Referring to claim 10, Clarkson discloses wherein said generating means



comprises changing means for changing a display layout of the at least one selection sentence according to at least one of a number of selection sentences and a length of each selection sentence (abstract, para. 20, para. 50, and Fig. 1-2 of Clarkson).

(I) Referring to claim 11, Clarkson discloses wherein said medical doctor terminal apparatus further comprises:

transmitting and storing means for entering a remedy policy for a patient, transmitting the entered remedy policy to said database server apparatus, and storing the transmitted remedy policy in said database server apparatus (abstract, para. 50, para. 23, para. 27, para. 54-56, para. 99, and Fig. 1-2 of Clarkson); and

third receiving means for receiving the stored remedy policy for the patient by accessing said database server apparatus, and displaying the received remedy policy (abstract, para. 50, para. 23, para. 27, para. 54-56, para. 99, Fig. 1-2 of Clarkson).

(J) Referring to claim 12, Clarkson discloses wherein said medical doctor terminal apparatus further comprises link controlling means for controlling said third receiving means in accordance with a command from an operator so that said third receiving means receives the stored remedy policy for the patient by accessing said database server apparatus and displays the received remedy policy, when said second receiving means receives the answer data and displays the received answer data (abstract, para. 50, para. 23, para. 27, para. 54-56, para. 99, and Fig. 1-2 of Clarkson).

(K) Referring to claim 13, Clarkson discloses wherein said database server apparatus comprises:

first storing means for storing information about each respective patient (abstract, para. 50, para. 99, and Fig. 1-2 of Clarkson);

second storing means for storing questions for medical doctor's questions for each respective question (abstract, para. 50, para. 99, Fig. 1-2 of Clarkson);

third storing means for storing information about linking between the respective patients and respective questions (abstract, para. 50, para. 99, and Fig. 1-2 of Clarkson); and

fourth storing means for storing answer data from said patient terminal apparatus (abstract, para. 50, para. 99, and Fig. 1-2 of Clarkson).

(L) Claims 15, 17-19, and 21-24 repeat the same limitations as those of claims 1, 3-5, and 7-13, and are therefore rejected for the same reasons given for those claims and incorporated herein.

(M) Referring to claim 27, Clarkson discloses wherein the generating means generates question programs which are dependent on a particular patient among a plurality of patients (para. 59 and 99 of Clarkson).

Clarkson and Kraftson do not expressly disclose wherein template storing means stores template question programs which correspond to predetermined answer forms and are not dependent on a particular patient, and inserting question sets received from said database server apparatus into the template question programs.

Jeacock discloses wherein template storing means stores template question programs which correspond to predetermined answer forms and are not dependent

on a particular patient, and presenting question programs which are dependent on a particular patient among a plurality of patients, by inserting question sets received from said database server apparatus into the template question programs (col. 1, lines 41-58 of Jeacock).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Jeacock within Clarkson and Kraftson. The motivation for doing so would have been to be able to customize the templates as necessary for any unique situations of the patient (col. 1, lines 41-58 of Jeacock).

(N) Claim 28 repeats the same limitations as claim 27 and is therefore rejected for the same reasons given for claim 27 above.

5. Claims 6, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarkson (US 2003/0046305 A1) in view of Kraftson et al. (6,151,581) in view of Jeacock et al. (6,014,630), in view of Tipirneni (US 6,381,029 B1), and further in view of Bair et al. (6,108,665).

(A) Referring to claims 6 and 20, Clarkson fails to expressly disclose wherein each of the question sets further includes a goal answer entered by a medical doctor.

Nevertheless, these features are old and well known in the art, as evidenced by Bair. In particular, Bair discloses wherein each of the question sets further includes a goal answer entered by a medical doctor (abstract and Fig. 1-34 of Bair).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bair with the combined teachings of Clarkson, Kraftson, Jeacock, and Tipirneni with the motivation of providing healthcare optimization (col. 2, lines 42-47 of Bair).

(B) Referring to claim 14, Clarkson discloses the system as claimed in claim 13, wherein said third storing means further stores an answer entered by a medical doctor, in addition to the information about linking between the respective patients and respective questions (Clarkson: abstract; ¶¶ [0050], [0099]; Fig. 1-2).

Clarkson, however, fails to expressly disclose wherein said third storing means further stores a goal answer. Nevertheless, these features are old and well known in the art, as evidenced by Bair. In particular Bair discloses wherein said third storing means further stores a goal answer (abstract; Fig. 1-34 of Bair).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Bair with the combined teachings of Clarkson, Kraftson, Jeacock, and Tipirneni with the motivation of providing healthcare optimization (col. 2, lines 42-47 of Bair).

### ***Response to Arguments***

6. Applicant's arguments filed 1/5/09 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 1/5/09.

(1) Applicant argues that nowhere in Jeacock does it disclose or suggest the actual generation of the question programs, as recited in the claims.

(A) As per the first argument, the Examiner respectfully submits that Clarkson teaches an "adaptive" questionnaire (see para. 99 of Clarkson). As such, it is readily apparent that these questions are being generated based on information received from the patient. Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/L. N./  
Examiner, Art Unit 3686  
ln  
2/3/09

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
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